

This Disposition is Not
Citable as Precedent
of the TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Mailed: July 31, 2003

Opposition No. 91125615

University of Southern
California

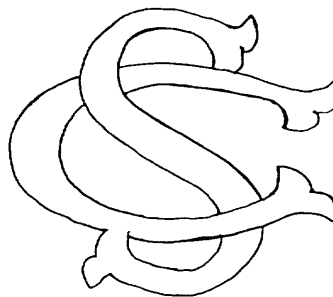
v.

University of South
Carolina

Before Quinn, Hairston and Rogers,
Administrative Trademark Judges.

Rogers, Administrative Trademark Judge:

The University of South Carolina (applicant) has applied to register a stylized version of the interlocking letters SC, as illustrated below. Registration is sought in International Class 25 for goods identified as "clothing; namely, hats, baseball uniforms, t-shirts and shorts."



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The University of Southern California (opposer) has opposed issuance of a registration to applicant, relying in its notice of opposition on its ownership of registration no. 1,844,953 for the mark SC (in typed form, i.e., devoid of any form of stylization). Opposer's SC mark is registered in four classes, including International Class 25 for goods identified as "sweatshirts and T-shirts, all goods being offered and sold at university-controlled outlets." The registration issued July 12, 1994.

Applicant's mark was published for opposition on May 18, 1999. Opposer obtained extensions of time to oppose totaling nearly three years, the vast majority with consent of applicant, while the parties attempted to settle their differences. Unable to reach an amicable settlement with applicant, opposer filed its notice of opposition on May 3, 2002.

Applicant timely filed an answer and counterclaim; and quickly thereafter filed an amended counterclaim. The Board accepted the amended counterclaim, as a matter of course, in view of its filing prior to any answer to the original counterclaim. Opposer moved to dismiss the counterclaim under Fed. R. Civ. P. 12(b)(6). The Board noted opposer's reliance on materials outside the pleadings and informed the parties that the motion would be treated as a motion for summary judgment. Each party was provided the opportunity

for supplemental briefing, in view of the Board's decision to treat the motion as one under Fed. R. Civ. P. 56. We now address the motion for summary judgment and, preliminarily, issues related thereto which have arisen as a result of the briefing of the motion.

Each party has, to some extent, complained about the evidentiary proffers of the other. Suffice it to say that when material that may be introduced at *trial* by Notice of Reliance is proffered in support of or in opposition to a motion for summary judgment, it need not be introduced by such a notice to be considered in conjunction with the motion for summary judgment. Mere attachment of such material to the motion or response brief is sufficient. We also note that the Board does not take judicial notice of Patent and Trademark Office records. *Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290 (TTAB 1986) and *Cities Service Co. v. WMF of America, Inc.*, 199 USPQ 493 (TTAB 1978). Finally, while many of the parties' arguments go to the probative value of particular submissions, the Board will not strike or refuse to consider materials merely because they are devoid of substantial probative weight.

Both opposer's original motion to dismiss and its reply brief offered in further support of the motion are broken out into a "motion" and an accompanying "request" that the Board (1) take "official [i.e., judicial] notice" and (2)

consider copies of "items already of record." As noted above, a party moving for summary judgment need not include a notice of reliance when submitting items in support of its motion. Moreover, even if such a notice were required, it should not serve as a vehicle for submitting a request to take judicial notice of other items that would not be admissible at trial by such a notice. Rather, any request that the Board take judicial notice of particular items, and the arguments offered in support of the merit in doing so, should be included in the moving party's brief. Including such arguments in an unnecessary filing smacks of an attempt to avoid the page limits on briefing a motion.¹ Finally, it is never necessary--at trial or on a motion for summary judgment--to submit copies of items which are specified by the trademark rules of practice to be considered "of record," such as the contents of the involved application file.

Applicant moved to strike opposer's reply brief and the associated "request for official notice and submission of items already of record," or, in the alternative, for leave to file a surreply. While applicant asserted that opposer

¹ In particular, the "request for official notice and submission of items already of record" that accompanied opposer's reply brief on the motion to dismiss, clearly includes argument that should be included in the reply brief itself. Were any of this argument counted against the page limit for a reply brief, the "request" and reply brief would exceed the page limit for a reply brief.

had engaged in an "egregious attempt to submit pages of new material," rather than limit its reply to addressing applicant's response to opposer's motion, applicant did not specifically argue that opposer's submissions, taken together, exceeded the page limitation for a reply brief. Instead, applicant essentially argued that the reply should not be considered because it rehashes arguments made in opposer's original motion and relies on new evidence that is improper to submit with a reply brief.

When the parties were informed by the Board that opposer's motion to dismiss would be treated as a motion for summary judgment, the Board noted that opposer had filed various exhibits and that they would be considered.² Moreover, the Board allowed applicant the opportunity to supplement its response to opposer's motion with additional material and allowed opposer time to file a supplemental reply brief. Implicit in the terms of such order is a determination that opposer's reply brief and the material submitted in tandem therewith would be considered. Thus, we consider applicant's motion to strike to have been effectively denied, and we decline to revisit that earlier interlocutory determination. Insofar as the motion to

² Some of the exhibits were submitted with the original motion to dismiss and some were submitted with the reply brief, in an attempt to overcome objections raised by applicant to the submissions that accompanied the original motion.

strike included an alternative motion for leave to file a surreply, and to the extent the prior interlocutory ruling did not rule on it, we deny the alternative request.

Trademark Rule 2.127(a) prohibits the filing of surreplies.

Applicant timely filed its additional response and exhibits to opposer's constructive motion for summary judgment. Opposer then timely filed its supplemental reply brief. However, opposer's supplemental reply brief, even without resort to the accompanying "notice of reliance" and "affidavit of Mandy Robertson-Bora" exceeds the page limit for a reply brief. See Trademark Rule 2.127(a).

Accordingly, we have not considered opposer's supplemental reply brief and its accompanying submissions. Finally, we have not considered the surreply filed by applicant in response to opposer's supplemental reply brief, because we have not considered the supplemental reply brief and, even if we had considered it, we would not consider a prohibited surreply.

In sum, then, to decide opposer's constructive motion for summary judgment on applicant's counterclaim, we have considered the original motion and accompanying submissions, the response and accompanying submissions, the reply and accompanying submissions, and applicant's additional response filed after it was informed that the motion to dismiss would be treated as a motion for summary judgment.

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Following consideration of these items, and applicable law, we grant opposer's motion and dismiss the counterclaim for the reasons that follow.

Applicant's counterclaim asserts three different grounds for cancellation of opposer's pleaded registration. We consider each in turn.

Opposer's Alleged Fraud on the USPTO

Applicant asserts that the mark registered by opposer was registered through opposer's perpetration of a fraud on the USPTO. Opposer's registration issued based on an intent-to-use [ITU] application, after opposer had received a notice of allowance and filed a statement of use [SOU]. While the amended counterclaim itself (specifically, paragraph 21) is not entirely clear as to what false representation purportedly was made, the parties' briefing of opposer's constructive motion for summary judgment indicates more than one theory supporting the fraud basis for the counterclaim.

Under one theory, applicant appears to believe that opposer's statement, in the ITU application, that it had a bona fide intent to use the applied-for mark in commerce subsequently was shown to be false, because the statement of use asserts actual use of the mark for each class of goods or services prior to the filing date of the application. See Response to opposer's motion to dismiss, p. 12 ("This

statement [regarding use, in the SOU] is false because [opposer] could not have filed an intent to use application if it had used the mark in commerce on all of the goods identified in the application in 1978 - 12 years earlier.") Under another theory, applicant is arguing that the statement of use is false, because the date of first use and/or date of first use in commerce set forth by opposer do not apply to each and every item in each class of goods.³ See *Id.* ("Pursuant to 37 C.F.R. § 2.88(c), if more than one item of goods is specified in a statement [of] use, [opposer] was under an affirmative duty to identify the particular item to which the dates of use applied.") And under a third theory, applicant notes that opposer has a "second application to register the letters 'SC' for the same goods," that the dates of use set forth in the second application are "after the date of [the] application" that matured into the registration that is the subject of applicant's counterclaim, so that applicant now "believes that the facts once developed through discovery may

³ A related theory which opposer initially believed applicant was advancing as the basis for the fraud ground for the counterclaim is rooted in an Office error. Specifically, though opposer set forth 1978 as the date of first use in commerce for each class of goods in its application, when the Office issued opposer a registration, it inadvertently listed 1978 as the date of first use in commerce for only one of the four classes and listed 1987 as the date of first use in commerce for the other three classes. Opposer apparently never bothered to request a correction of its registration certificate. Though opposer initially believed this discrepancy to be at the root of applicant's fraud allegations, it is clear that it is not.

establish that [opposer] did not begin using the letters 'SC' in earnest as a trademark until 1993 or 1994." *Id.*

Opposer argues that it filed an intent to use application because, at the time of filing, it had used its SC mark on some of the goods in the four covered classes, but not on all the goods; that it was, when opposer filed the application, permissible for an applicant that had not used its mark on every item listed in an application to file the entire application under the intent to use provisions of the Lanham Act and, after subsequently making use of the mark on or in connection with all items, to file an allegation of use stating so; that in filing an allegation of use under such circumstances, it is entirely proper to assert a date of first use and a date of first use in commerce for each class that may relate to one or more, but not all, goods in the class; and that Trademark Rule 2.88(c), insofar as it specifies that, when dates of use in a statement of use pertain to only one item, then the particular item to which the dates apply should be specified, is permissive, not mandatory. In addition, opposer argues, in essence, that even if its statement of use is considered to include a false statement or misrepresentation, it was not relied on by the USPTO in deciding to approve issuance of opposer's registration. Specifically, opposer reasons that if there was any concern

about whether the dates of use applied to all items in the application, inquiry could have been made of opposer; and because such inquiry was not made, the USPTO clearly did not rely on the alleged misstatement.

Both of the first two theories for applicant's fraud claim are dependent on a particular reading of the statement of use filed by opposer. Specifically, the statement of use must be read as asserting that the recited dates of first use and first use in commerce were applicable to each and every item in the four classes of goods, rather than to just one or more items (but not all items) in each class. In addition, applicant urges that how the statement of use is to be read is a disputed matter of fact, so that it would be inappropriate to enter summary judgment dismissing the counterclaim, at least insofar as it is based on opposer's alleged fraud. Applicant's reasoning is faulty.

If we assume applicant's reading of the statement of use is correct, notwithstanding that opposer asserts the statement should not be so read, then applicant's first theory of fraud is that applicant's misrepresentation is rooted in the allegation, in the original ITU application, that opposer had a bona fide intention to use when it had, in fact, already made use for all the goods. Of course, opposer has already pointed out that from the Office's point of view, there is absolutely nothing wrong with an applicant

filing under intent to use and later asserting use dates which predate its filing date.⁴ See opposer's motion to dismiss, page 17, footnote 10. Such a practice is, we note, entirely consistent with the ability of an intent-to-use applicant, in defending an opposition, to attempt to prevail on the issue of priority by relying on proof of actual use prior to its filing date. See *Corporate Document Services Inc. v. I.C.E.D. Management Inc.*, 48 USPQ2d 1477, 1479 (TTAB 1998) ("Just as an applicant in a use-based application can rely, for purposes of priority in a proceeding such as this, upon use (including use analogous to trademark use) prior to the filing date of its application, or even prior to its claimed use dates, an intent-to-use applicant is entitled to rely upon actual use, or use analogous to trademark use, prior to the constructive use date of the intent-to-use application." *Footnote and citation omitted*). It would, of course, be entirely illogical to allow an opposed intent-to-use applicant to rely on proof of use prior to its filing date in defending an opposition, dismiss an opposition, issue the applicant a notice of allowance, and to later preclude that applicant from filing a statement of use relying on dates reflective of its actual use.

⁴ Opposer has also argued that there is a certain compelling logic in the practice, in that any party that has begun using a mark and is seeking registration of the mark likely has a bona fide intention to use the mark. We do not disagree, but the point has played no role in our decision of the pending motion.

The significance of this is that it demonstrates that even if opposer had actually used its mark on all its goods prior to filing for registration under intent to use, rather than on a claim of actual use, it would not have been *material* to the Office's determination whether to approve the application. Thus, the first theory of applicant's fraud claim must fail; we see no set of facts that applicant could prove in support of the theory that would entitle it to prevail.

We now turn to the second theory for the fraud basis for applicant's counterclaim. Under that theory, applicant does not target the statement in opposer's application of opposer's bona fide intent to use but, rather, the statement of use filed subsequently. Applicant maintains that the statement must be read as asserting use in commerce for each and every item in the various classes, as of the sole date of first use asserted in the SOU.⁵ Again, however, even if we assume applicant's reading of the statement is correct, it would not be material to the Office's decision whether to approve registration of opposer's mark. Applicant misreads the case law in reaching any contrary conclusion.

⁵ Opposer concedes that the SOU should be read as asserting the date of first use (1926) and date of first use in commerce (1978) applies to each class. Opposer denies that the SOU should be read as asserting those dates apply to each item in each class.

The SOU filed by opposer clearly includes a statement, separate from the dates of first use and first use in commerce, that opposer was using the mark in commerce on all the goods at the time the SOU was filed. Even if opposer had not used the mark in commerce in 1978 for all the goods, but deliberately crafted a vaguely-worded SOU to mislead the examining attorney into thinking that opposer had done so, it would not have been material to the decision whether to approve the mark for registration. Opposer correctly relies on the following statement from *CarX Service Systems, Inc. v. Exxon Corp.*, 215 USPQ 345, 351 (TTAB 1982): "A misstatement of the date of first use in the application is not fatal to the securing of a valid registration as long as there has been valid use of the mark prior to the filing date." (Citations to supporting authorities omitted.) This statement, of course, relates to registrations issuing on use-based applications. For an ITU application, there must be valid use on all goods prior to the filing of the SOU. See 37 C.F.R. § 2.88(c). Applicant's reading of the same case as requiring a different result is mistaken.

Applicant and opposer disagree as to whether the Trademark Rule 2.88 is permissive or mandatory in regard to its direction that an applicant who asserts a date of first use in commerce specify the item to which it relates, when it does not relate to all items. Even if we assume that

applicant is correct in arguing that the provision is mandatory, not permissive, we agree with opposer that its asserted failure to comply with the provision would not have been material to the determination of the registrability of the mark. Applicant has cited no authority to the contrary and we are not aware that any exists. As with the first theory underlying the fraud basis for applicant's counterclaim, we see no set of facts that applicant could prove in support of the theory that would entitle it to prevail.

We now turn to the third theory of fraud. Under this theory, construed liberally, applicant essentially is targeting the statement in the SOU that the opposer's mark was, when the SOU was filed, then in use in commerce on all of the identified goods. Under this third theory, the date of first use in commerce for at least some of the goods would be after the filing date of the SOU. If this were proved, it would, indeed, prove fatal to the registration, for reasons already discussed. However, the only basis for applicant's advancement of this theory stems from applicant's observation that opposer filed a separate application for an SC mark, for the same goods,⁶ in which

⁶ In fact, the subsequent application includes many more goods than the registration applicant seeks to cancel. For the sake of considering this argument, it does not matter whether the goods in the subsequent application are precisely the same or merely include the goods from opposer's registration.

the asserted date of first use in commerce [specifically, 1994] is after the filing date of the application that matured into opposer's registration. Thus, applicant has concluded "discovery may establish that [opposer] did not begin using the letters 'SC' in earnest as a trademark until 1993 or 1994." Response to opposer's motion to dismiss, page 13.

That the asserted date of first use in commerce in the subsequent application is after the *filing date* of the application that resulted in issuance of opposer's now challenged registration is immaterial, because it is the date of filing of the SOU that would be important. The SOU that resulted in issuance of the registration was not filed until January 20, 1994. Nonetheless, since the date of first use in commerce asserted in the subsequent application, for each class, is merely 1994, the USPTO would construe that date as December 31, 1994, i.e., a date after the filing date of the SOU in the earlier application. Of course, in any challenge to the subsequent application or any registration issuing thereon, opposer would be free to try and prove use prior to December 31, 1994, including use prior to January 20, 1994. See *Corporate Document Services, supra*. If opposer actually did prove use prior to January 20, 1994, it would undermine applicant's third theory of fraud.

Even if we assume that opposer could not show use of the stylized mark in its subsequent application until after January 20, 1994, this would be immaterial to any issue relating to the registered SC (in typed form) mark. The subsequent application deals with the mark in a particular form of interlocking, stylized lettering. If opposer did not use the mark SC in that form of lettering until 1994, it could not have asserted dates of use in commerce that would apply only to other forms of lettering. We see no objective basis for applicant's apparent conclusion that, because opposer did not begin using SC in a particular form of lettering until some time in 1994 that its existing registration which does not involve a claim of use of that form of lettering, is somehow called into question. This third theory of fraud represents, at best, a vague, subjective hope of applicant's that, during discovery, it may find some basis for a fraud claim. Even though the law allows for pleading elements of a fraud claim on information and belief, we do not believe it permits a fraud claim with no objective support to be pursued merely because an adversary has, in filing separate applications for different marks, set forth different dates of use.

The Claim Under Section 2(b) of the Statute

The second basis for applicant's counterclaim is its assertion that opposer's registration of the typed mark SC

constitutes registration of "other insignia" of the state of South Carolina.⁷ Much of the material submitted by the parties in briefing opposer's constructive motion for summary judgment has been submitted because it is perceived to have a bearing on applicant's claims under Section 2(b) and under Section 2(a), the latter of which is discussed *infra*.

In essence, opposer's motion for summary judgment seeks to establish, in regard to applicant's claim under Section 2(b), that the letters SC alone are not an official insignia of the state of South Carolina, in contrast to seals, flags, and other such items. To support its position, opposer relies on the registration of various marks consisting of or containing the letters SC as evidence that the letters alone cannot constitute an insignia of the state of South Carolina, or else the referenced registrations would not have been permitted to issue by the USPTO or be allowed to remain on the register without challenge by the state of South Carolina. By analogy, opposer also points to registrations that contain the letters US, to demonstrate

⁷ "Other insignia" is a catchall provision of Section 2(b). Though some of applicant's arguments in support of allowing this claim to proceed note that the letters SC are used on flags or in seals associated with the state of South Carolina, we do not believe applicant is claiming, or could claim, that the typed letters alone constitute a flag or coat of arms, i.e., the two specific types of indicia of governmental authority (of a state or of the United States) that are prohibited from registration by Section 2(b).

that those letters alone do not constitute an insignia of the United States, in contrast to the flag, seals, and other such symbols.

Applicant seeks either to have opposer's submissions disregarded as improperly submitted or discounted as unworthy of very much probative weight. The following passage from applicant's supplemental brief in response to opposer's constructive motion for summary judgment aptly summarizes applicant's position:

[D]espite [opposer's] failure to carry its burden of proof for a summary judgment motion, [applicant] has submitted contrary evidence to clearly establish the existence of a factual dispute. The letters "SC" have been adopted as an insignia or flag of the state of South Carolina. Specifically, *Exhibits 5, 9, 11, 13, 14, 15, 16, and 17* submitted herewith demonstrate that the letters "SC" appeared on flags, uniforms, and weaponry throughout the [sic] South Carolina's history. Further, at various times throughout its history, the state of South Carolina has utilized the letters "SC" as part of the state's seal. (See Exhibit 14). Finally, official institutions of the state of South Carolina have adopted and currently use the letters "SC" in connection with the work of the government of South Carolina. (See Exhibits 3-9, 11, and 13-17). As a result of its multiple evidentiary submissions, South Carolina has created a factual issue as to whether the letters "SC" form an insignia for the state of South Carolina. (Italics and underscoring by applicant.)

We agree with applicant that our case law prohibits opposer from introducing third-party registrations merely by list. However, opposer has introduced reprints of the information regarding these registrations from an Office

database, which is an acceptable means for making the registrations of record. As the moving party on the motion for summary judgment, opposer must show that there is no genuine dispute as to any material fact and that it is entitled to judgment as a matter of law. Opposer, having introduced eleven third-party registrations for the letters SC alone and having demonstrated that relevant case law interpreting the "other insignia" provision of Section 2(b) does not recognize initials per se as official insignia of a government, has shifted the burden of persuasion to applicant. Though applicant has made much material of record, it has failed to show that there is a genuine issue of material fact for trial and that opposer is not entitled to judgment under the applicable law dismissing the Section 2(b) claim.

The Board has held that Section 2(b) protection of "other insignia" of the United States "is restricted in its application to insignia of the same general class as 'the flag or coats of arms' of the United States." In re United States Department of the Interior, 142 USPQ 506, 507 (TTAB 1964). "The term 'national insignia,' as used in [15 U.S.C. §1052(b)], is restricted to the official symbols of a government." Vuitton et Fils S.A. v. J. Young Enterprises, Inc. et al., 212 USPQ 85, 89 (9th Cir. 1981). In a case involving initials, the Board held that "the initials of the

Marine Corps... cannot be construed as an 'other insignia of the United States' under Section 2(b) of the Lanham Act. The letters 'USMC' are nothing like a flag or coat of arms. These types of insignia are pictorial in nature, they can be described, but cannot be pronounced." U.S. Navy v. U.S. Manufacturing Co., 2 USPQ2d 1254, 1256 (TTAB 1987). Also, the Board has held that a "composite mark consisting of elements and symbols indicative of and used by the United States Postal Service... may not be regarded as an insignia of the United States Government, and, thereby, be refused registration under Section 2(b) of the Statute..." In re Brumberger Co., Inc., 200 USPQ 475, 477 (TTAB 1978).

While the case law we have referenced deals with the question of what qualifies as "other insignia" of the United States, we find these precedents illustrative of what will qualify as an "other insignia" of a state government. Thus, the initials of the state of South Carolina would not be considered an official insignia of the state. It is insufficient to establish that the initials are used by the U.S. Postal Service to direct mail to the state; each state establishes its own official symbols, seals, flags, and "other insignia," not the Postal Service or any other agency of the United States government. Likewise, it is insufficient to establish that the letters SC may be an element in designs, symbols or seals that could be

considered "other insignia," so that the letters alone might be considered "indicative" of the state. While opposer has shown that the initials SC per se have been registered by entities other than the state of South Carolina, applicant has not pointed to any countervailing evidence that creates a genuine issue of fact about whether the state of South Carolina has enacted any law, or taken any action, to assert that SC is one of the state's official symbols or insignia. Nor has applicant articulated any argument why we should draw an exception to the case law that holds that initials are not considered "other insignia" under Section 2(b).

The Claim Under Section 2(a) of the Statute

Though initials may not be protectible as "other insignia" under Section 2(b) of the Lanham Act, registration may nonetheless be refused if use is deceptive or falsely suggests a connection to a government or government entity. Compare U.S. Navy, *supra*, with Brumberger, *supra*. In the former, the Section 2(a) claim was dismissed; in the latter, it provided the basis for refusal of registration.

There is, however, a threshold problem, which neither party has addressed, and which prevents applicant from invoking its claim of false suggestion of a connection. A Section 2(a) claim of false suggestion of a connection must be pressed by the entity with which the challenged mark is uniquely associated. See, *Heroes Inc. v. Boomer Esiason*

Hero's Foundation, 43 USPQ2d 1193, 1197 (Dist. D.C. 1997) ("In other words, to raise a claim that a mark falsely suggests a connection with an institution under Section 2(a), the challenger must be the institution itself."). Accord, Estate of Biro v. Bic Corp., 18 USPQ2d 1382, 1385 (TTAB 1991) ("...a Section 2(a) plaintiff has standing by virtue of who the plaintiff is, that is, the plaintiff's personality or 'person.'"); National Aeronautics and Space Administration v. Bully Hill Vineyards Inc., 3 USPQ2d 1671, 1676 (TTAB 1987) ("While a party's interest in its identity does not depend for its existence on the adoption of and use of a technical trademark, a party must nevertheless have a protectible interest in a name (or its equivalent). Where a name claimed to be appropriated does not point uniquely and unmistakably to that party's personality or 'persona,' there can be no false suggestion.") (emphasis added).

Applicant does not claim that the letters SC falsely suggest a connection with applicant's persona or identity. Rather, applicant asserts that the letters SC falsely suggest a connection with the state of South Carolina. It is the state itself that would have to raise such a claim, not an agency thereof.⁸ Accordingly, the Section 2(a) basis for applicant's counterclaim also fails.

⁸ We acknowledge the decision of our primary reviewing court in Jewelers Vigilance Committee, Inc. v. Ullenberg Corp., 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987), which allowed a nonprofit

Even if applicant were able to pursue the Section 2(a) claim based on its argument that opposer's registered mark falsely suggests a connection with the state of South Carolina, we would find that opposer has shown that SC has been registered by numerous other entities and has, therefore, shifted the burden to applicant to show that there is a genuine issue for trial regarding whether the initials SC are uniquely and unmistakably associated with the state. Further, we would find that applicant has not established a genuine issue of fact for trial.

In so ruling, we repeat the following passage from an earlier Board decision involving initials of a governmental entity:

It seems unreasonable in this day and age where there is a plethora of governmental agencies and departments identified by their initials and a tendency of commercial organizations to adopt and use designations comprising the initial letters of the various components of their corporate names as trademarks for goods to preclude, in the absence of a statutory prohibition against any and all use of an abbreviation or name used by a particular governmental agency or department, the registration of the name or a similar term by a commercial organization where, as here, the circumstances surrounding such use are not

trade association to pursue Section 2(a) and Section 2(d) claims even though it had no proprietary interest of its own being asserted. It is unclear from that decision, however, what provision of Section 2(a) was at issue. In footnote 1, which recites the involved provisions of Section 2 of the Lanham Act, the only portion of Section 2(a) that is listed is the "immoral, deceptive, or scandalous matter" provision. Moreover, we believe Jewelers Vigilance is distinguishable on its facts, as that case involved an acknowledged "watchdog" for its industry and the members of the trade association. Applicant is not the "watchdog" for the state of South Carolina.

calculated or likely to mistakenly cause purchasers to associate such commercial activities with a governmental body.

Federal Bureau of Investigation v. Societe: "M. Brill & Co.", 172 USPQ 310, 315 (TTAB 1971), aff'd, 187 USPQ 685 (D.C.D.C. 1975).

In this regard, we also note that each class of goods in opposer's registration is restricted to sale through "university authorized channels of trade" or "sold at university-controlled outlets." Such restrictions tend to suggest that prospective purchasers of opposer's SC-branded goods will likely know they are goods of the University of Southern California or "Southern Cal." Applicant has not established why, notwithstanding these trade restrictions, there is an issue for trial about the likelihood that sales would be made in circumstances such that prospective purchasers would unmistakably draw an association between opposer's mark and the state of South Carolina.

Conclusion

Judgment is hereby entered in opposer's favor and applicant's counterclaim is dismissed in its entirety.⁹ Proceedings are resumed; discovery and trial dates are reset as follows.

⁹ We note, however, that insofar as the counterclaim is based on a claim of fraud, dismissal is without prejudice to re-filing on applicant's third theory for that claim, if applicant discovers specific facts or documents that would support a claim that opposer did not use its registered mark in commerce for each item

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THE PERIOD FOR DISCOVERY TO CLOSE: November 7, 2003

Testimony period for party in
position of plaintiff to close February 5, 2004
(opening thirty days prior thereto)

Testimony period for party in
position of defendant to close April 5, 2004
(opening thirty days prior thereto)

Rebuttal testimony period to close May 20, 2004
(opening fifteen days prior thereto)

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within 30 days after completion of the taking of testimony. See Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

in each class of its registration prior to filing the SOU that led to issuance of opposer's registration.